



# UNITED STATES PATENT AND TRADEMARK OFFICE

27

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/689,327

10/20/2003

Daniel J. Hassett

10738-51

2859

24256

7590

05/01/2006

DINSMORE & SHOHL, LLP  
1900 CHEMED CENTER  
255 EAST FIFTH STREET  
CINCINNATI, OH 45202

EXAMINER

ZEMAN, ROBERT A

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/689,327	Applicant(s) HASSETT ET AL.	
	Examiner Robert A. Zeman	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 3-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 2-2-2006 is acknowledged. The traversal is on the ground(s) that it would not be unduly burdensome for the Examiner to examine all the claims especially claims 1-4 whose subject matter was classified in the same class. Moreover, the goal of groups I and II are the same. Finally, there would be substantial overlap in the searches of the various groups. This is not found persuasive because while the goals of groups I and II may be the same, the reagents they employ are not. Moreover, the searches of the various groups would not be coextensive in scope. Hence each group would require a different search. This constitutes an undue burden.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-8 are pending. Claims 3-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Claims 1 and 2 are currently under examination.

### ***Drawings***

The drawings filed on 10-20-2003 are objected to, as the reproductions of gels are of such poor quality they were unreadable.

### ***Claim Rejections***

#### ***35 USC § 112, Enablement***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1645

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of detecting a *Pseudomonas aeruginosa* infection by the detection of its porin F protein (OprF), does not reasonably provide enablement for methods for assessing cystic fibrosis disease based on the presence or absence of any outer membrane protein generally, or OprF specifically. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims.

Enablement is considered in view of the Wands factors (MPEP 2164.01(A)). These include: nature of the invention, breadth of the claims, guidance of the specification, the existence of working examples, state of the art, predictability of the art and the amount of experimentation necessary.

**Nature of the invention:** The instant claims are drawn to methods of assessing cystic fibrosis disease by detecting the presence or absence of outer membrane protein in a sample.

**Breadth of the claims:** The claims encompass all outer membrane proteins any cell type or organism. Moreover, as the specification defines “assessment” as referring to the prognosis, monitoring, delaying progression, delaying early death, staging, predicting progression, predicting response to therapy regimen, tailoring of a therapy regimen, of Cystic Fibrosis disease based on the presence or absence of an outer membrane protein, the instant claims encompass the detection of any of the aforementioned proteins to achieve any of the aforementioned goals.

**Guidance of the specification:** The specification discloses that *Pseudomonas aeruginosa* infection is prevalent in CF patients and that OprF can be harvested from freshly excised lungs of CF patients. The specification further discloses that CF lung disease has been shown to dramatically worsen when *Pseudomonas aeruginosa* converts to the mucoid, alginate-overproducing form. Said conversion is coupled to the anaerobic growth of said bacteria and an increased production of OprF. Finally, the specification defines “assessment” as referring to the prognosis, monitoring, delaying progression, delaying early death, staging, predicting progression, predicting response to therapy regimen, tailoring of a therapy regimen, of Cystic Fibrosis disease based on the presence or absence of an outer membrane protein. However, the specification is silent on how said goals are to be accomplished using a single time point detection of a protein.

**State of the art:** The art teaches that chronic *Pseudomonas aeruginosa* infection is associated with CF disease. The art further teaches that porin protein F (also known as OprF) is localized on the surface of the bacterial cell and is readily available for antibody binding (see Mutharia et al. Infection and Immunity, 1998, Vol. 42 No. 3, pages 1027-1033). Thus OprF is a good target for diagnostic methodologies. The art is silent with regard to any other outer membrane proteins that have either a direct or indirect correlation with CF disease.

Consequently, due to the lack of guidance in art and in the specification, the claims are not enabled for the full breadth of the claims.

***35 USC § 112, Written Description***

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, first paragraph "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

The instant claims are drawn to methods of assessing cystic fibrosis disease by detecting the presence or absence of outer membrane protein in a sample wherein "assessing" is defined as referring to the prognosis, monitoring, delaying progression, delaying early death, staging, predicting progression, predicting response to therapy regimen, tailoring of a therapy regimen, of Cystic Fibrosis disease based on the presence or absence of an outer membrane protein. The instant claims all outer membrane proteins any cell type or organism whereas the specification only discloses the prevalence of *Pseudomonas aeruginosa* infections among CF patients and that OprF is readily found in CF patients with a *Pseudomonas aeruginosa* infection. The specification fails to describe any other outer membrane protein that is either directly or indirectly associated with CF.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written

Art Unit: 1645

description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116.)

The skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404. 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and does so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by

Art Unit: 1645

structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." *Id.* at 1170, 25 USPQ2d at 1606.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rendered vague and indefinite by the parenthetical use of the term "OprF". It is unclear whether said term is meant to be an abbreviation for outer membrane proteins generally or is referring to the porin F protein of *Pseudomonas aeruginosa*. If the latter is the case it is unclear whether it is meant to be a limitation of the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –



Art Unit: 1645

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mutharia et al.

(Infection and Immunity, 1983, Vol. 42 No. 3, pages 1027-1033).

Mutharia et al. disclose measuring OprF in *Pseudomonas aeruginosa* isolates from CF patients (see abstract and page 1029).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Mutharia et al. (Infection and Immunity, 1983, Vol. 42 No. 3, pages 1027-1033).

Art Unit: 1645

Mutharia et al. disclose measuring OprF in *Pseudomonas aeruginosa* isolates from CF patients (see abstract and page 1029).

Mutharia et al. differs from the instant invention in that they do explicitly disclose the direct testing of surface liquid, sputa or combinations thereof.

Since Mutharia et al. disclose that OprF levels can be detected in *Pseudomonas aeruginosa* from CF patients, it would have been obvious for one of ordinary skill in the art to use the detection of OprF in biological samples to determine whether a given CF patient had a *Pseudomonas aeruginosa* infection.

One would have had a reasonable expectation of success as Mutharia et al. disclose that OprF was present on *Pseudomonas aeruginosa* from CF patients.

### ***Conclusion***

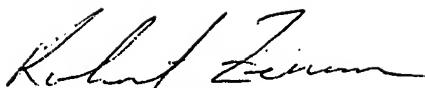
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (571) 272-0866. The examiner can normally be reached on Monday- Thursday, 7am -5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ROBERT ZEMAN  
PATENT EXAMINER

April 26, 2006